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OFFICE OF PETITIONS

In re Application of :
Leventhal et al. :
Application No. 10/633,179 : DECISION ON APPLICATION
Filed: August 1, 2003 : FOR
Atty Docket No. 25739-024 : PATENT TERM ADJUSTMENT
:

COPY

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT", filed March 18, 2009, which is properly treated under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be increased from three hundred twenty three (323) days on the basis, in part, that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is granted to the extent indicated herein.

However, the determination of patent term adjustment at the time of mailing of the Notice of Allowance remains THREE HUNDRED TWENTY-THREE (323) days.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On December 18, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 323 days. Applicants timely filed the instant application for patent term adjustment².

Applicants dispute the reduction of 192 days for their response filed October 20, 2006. Applicants assert they should have been assessed a period of reduction of 91 days for applicant delay in responding to the non-final Office action of January 11, 2006. Applicants assert that they filed a response to the non-final Office action, accompanied by a request for an extension of time with the third month (and fee) on July 11, 2006. Thus, the date of July 11, 2006, should have been used for their date of response and a period of reduction of 91 days should have been entered.

Applicants are correct. A review of the application history reveals that no response to the non-final Office action of January 11, 2006, was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed August 22, 2006. The record establishes that, in response, on September 6, 2006, applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed November 14, 2006, the petition was granted on the basis that applicants had shown that a response was filed on July 11, 2006.

Applicants did fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action within the meaning of § 1.704(b), but not by 192 days. The date of receipt of the response to the non-final Office action was July 11, 2006, which was three months and 91 days after the non-final Office action was mailed. See 37 CFR 1.704(b). It is, therefore, appropriate to enter a reduction of the patent term adjustment of 91 days.

² The issue fee was paid on March 18, 2009. Accordingly, applicant timely filed the instant request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.704(b) with the payment of the fee set forth in 37 CFR 1.18(e).

Accordingly, the period of reduction of 192 days is being removed and a period of reduction of 91 days is being entered.

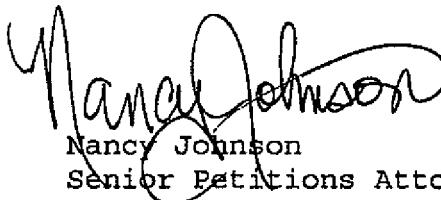
However, the response filed July 11, 2006 contained an omission. This omission was corrected by way of the filing of the compliant amendment on October 20, 2006. Accordingly, pursuant to 37 CFR 1.704(c)(7), a period of reduction of 101 days is being entered for the period beginning on the day after the date a reply containing an omission was filed, July 12, 2006, and ending on October 20, 2006, the date of filing of the response correcting the omission.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 323 days (606 days of Office delay - 283 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to the patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of revised PALM screen

Day : Wednesday

PALM INTRANET

Date: 9/30/2009
Time: 18:46:06

PTA Calculations for Application: 10/633179

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|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 08/01/2003 | PTO Delay (PTO): | 606 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 283 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 323 |
| PTO Delay Adjustment: | 0 | | |

File Contents History

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| 98 | 09/30/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 91 | |
| 97 | 09/30/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 192 | | |
| 90 | 12/18/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 89 | 12/17/2008 | ISSUE REVISION COMPLETED | | | |
| 88 | 12/17/2008 | DOCUMENT VERIFICATION | | | |
| 87 | 12/17/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 86 | 12/16/2008 | NOTICE OF ALLOWABILITY | | | |
| 81 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 80 | 11/18/2008 | REFERENCE CAPTURE ON IDS | | | |
| 79 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 78 | 12/11/2008 | DATE FORWARDED TO EXAMINER | | | |
| 77 | 11/18/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 76. | 12/11/2008 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 73 | 11/18/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 72 | 11/18/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 71 | 09/16/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 70 | 08/26/2008 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 69 | 08/22/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 68 | 08/22/2008 | ISSUE REVISION COMPLETED | | | |
| 67 | 08/22/2008 | DOCUMENT VERIFICATION | | | |
| | | NOTICE OF ALLOWANCE DATA VERIFICATION | | | |

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| 66 | 08/22/2008 | COMPLETED | | | |
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| 60 | 07/07/2008 | NEW OR ADDITIONAL DRAWING FILED | | | |
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| 46 | 10/20/2006 | RESPONSE AFTER NON-FINAL ACTION | | 192 | 30 |
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| 34 | 11/14/2006 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
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| 31 | 08/21/2006 | ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION | | | |
| 30 | 01/11/2006 | MAIL NON-FINAL REJECTION | | | |
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| 28 | 01/12/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |

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| 27 | 12/14/2005 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 26 | 10/27/2005 | DATE FORWARDED TO EXAMINER | | |
| 25 | 10/13/2005 | RESPONSE TO ELECTION / RESTRICTION FILED | | |
| 24 | 10/13/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | |
| 23 | 07/13/2005 | MAIL RESTRICTION REQUIREMENT | 285 | -1 |
| 22 | 07/11/2005 | REQUIREMENT FOR RESTRICTION / ELECTION | | |
| 21 | 06/03/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | |
| 20 | 06/03/2004 | CASE DOCKETED TO EXAMINER IN GAU | | |
| 19 | 01/12/2004 | REFERENCE CAPTURE ON IDS | | |
| 18.7 | 01/12/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 18 | 01/12/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | |
| 17 | 12/30/2003 | NEW OR ADDITIONAL DRAWING FILED | | |
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| 11 | 02/12/2004 | APPLICATION IS NOW COMPLETE | | |
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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